REMARKS

The Examiner has objected to Claims 54, and 55 due to informalities. Applicant respectfully asserts that such objection is avoided due to the amendments made hereinabove to such claims.

The Examiner has rejected Claims 51-55 under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant respectfully asserts that such rejection is avoided due to the amendments made hereinabove to Claims 51 and 54.

The Examiner has rejected Claims 51-53 under 35 U.S.C. 102(e) as being anticipated by Boesch et al. (U.S. Patent No. 6,092,053). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to the independent claim. Specifically, applicant has amended the independent claim to at least substantially include the subject matter of former dependent Claim 54.

With respect to the independent claim, the Examiner has relied on Col. 7, lines 18-20 from the Boesch reference, as excerpted in part below, to make a prior art showing of applicant's claimed technique where "after obtaining the member identifier, a unique identifier for the user [is stored] on a user computer system in conjunction with the obtained member identifier" (as currently amended).

> "In the preferred embodiment, the browser identifier is a cookie. A browser identifier identifies the consumer browser on a specific consumer computer. The CIS software receives and processes the message to determine if the consumer's browser contains an identifier which identifies a consumer that matches a data entry in a file in the consumer data structure of the CIS 206." (Col. 7, lines 17-23 — emphasis added)

Applicant respectfully asserts that the excerpt from the Boesch reference relied upon by the Examiner merely discloses that "[a] browser identifier identifies the consumer browser on a specific consumer computer" where "the browser identifier is a cookie" (emphasis added). However, the mere disclosure of a cookie as a browser identifier which identifies a consumer computer, as in Boesch, fails to suggest a

technique where "after obtaining the member identifier, storing a unique identifier for the user on a user computer system in conjunction with the obtained member identifier" (emphasis added), as claimed by applicant. Clearly, a cookie identifying a consumer browser, as in Boesch, simply fails to even suggest "storing a unique identifier for the user on a user computer system in conjunction with the obtained member identifier" (emphasis added), in the manner as claimed by applicant.

In fact, applicant notes that Boesch only teaches that the "CIS software receives and processes the message to determine if the consumer's browser contains an identifier which identifies a consumer that matches a data entry in a file in the consumer data structure of the CIS" (Col. 7, lines 19-23). Clearly, Boesch only discloses that the message indicates whether the browser contains a single identifier, and that the CIS determines whether such identifier matches a data entry in a file. To this end, Boesch simply does not meet applicant's claimed "storing a unique identifier for the user on a user computer system **in conjunction with** the obtained member identifier" (emphasis added), as claimed by applicant.

Further, with respect to the independent claim, the Examiner has relied on Col. 7, lines 18-22 from the Boesch reference (reproduced above) to make a prior art showing of applicant's claimed "reading from the user computer system the unique identifier stored in conjunction with the member identifier received."

Applicant respectfully asserts that the excerpt from Boesch relied upon by the Examiner merely discloses that "[t]he CIS software receives and processes the message to determine if the consumer's browser contains an identifier which identifies a consumer that matches a data entry in a file in the consumer data structure of the CIS" (emphasis added). However, the mere disclosure of a browser containing an identifier identifying a consumer that matches a data entry in a file of the consumer data structure, as in Boesch, simply fails to suggest "reading from the user computer system the unique identifier stored in conjunction with the member identifier received" (emphasis added), as claimed

by applicant. Clearly, the <u>browser identifier</u>, as in Boesch, cannot meet both the "unique identifier," and the "member identifier received," in the manner as claimed by applicant.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the above reference, as noted above. Thus, a notice of allowance or a proper prior art showing of <u>all</u> of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

With respect to the subject matter of former Claim 54 (now at least substantially incorporated into the independent claim), the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Boesch, in view of Watson (U.S. Patent No. 5,978,780). Specifically, the Examiner has relied on Col. 16, line 63 – Col. 17, line 8 from the Watson reference, as excerpted below, to make a prior art showing of applicant's claimed techniques "wherein the method is practiced on behalf of a first online service" and "wherein obtaining for the user the member identifier comprises obtaining for the user a member identifier used by the user to identify the user to a second online service distinct from the first online service" (as presently claimed).

> "1. The data record contains HH-PSX#, the unique identifying number for households HH(i) keying to all other personal service exchange (PSX) databases and data views, including other service establishment (SE), financial institutions (FIN) and historical transactions and profile data.
>
> 2. The data record also contains the unique personal service exchange (PSX) identifying number for the current transmitting service establishment SE(j), identifying it to the personal settlements exchange (PSX), and triggering links to other

elements of the process system in personal settlement exchange
(PSX), such as retrieval of financial institution (FIN) accounts
associated with the service establishment (SE)." (Watson, Col.
16, line 63 -- Col. 17, line 8 -- emphasis added)

Applicant respectfully asserts that the excerpt from Watson relied upon by the
Examiner merely discloses an "HH-PSX#," which is "the unique identifying number for
households HH(l) keying to all other personal service exchange (PSX) databases and data
views" (emphasis added). Further, Watson discloses that "[t]he data record also contains
the unique personal service exchange (PSX) identifying number for the current
transmitting service establishment SE(j)" (emphasis added).

However, the mere disclosure of a unique identifying number for household
keying to all other personal service exchange databases, or that a data record contains the
unique personal service exchange identifying number, as in Watson, fails to suggest a
technique "wherein the method is practiced on behalf of a first online service" or
"wherein obtaining the member identifier comprises obtaining for the user a member
identifier used by the user to identify the user to a second online service distinct from the
first online service" (emphasis added), as claimed by applicant. Clearly, a unique number
for households keying to all other PSX databases, as in Watson, simply fails to even
suggest "obtaining for the user a member identifier used by the user to identify the user to
a second online service distinct from the first online service" (emphasis added), as
claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met.
First, there must be some suggestion or motivation, either in the references themselves or
in the knowledge generally available to one of ordinary skill in the art, to modify the
reference or to combine reference teachings. Second, there must be a reasonable
expectation of success. Finally, the prior art reference (or references when combined)
must teach or suggest all the claim limitations. The teaching or suggestion to make the
claimed combination and the reasonable expectation of success must both be found in the
prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d
1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 55, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Boesch, in view of Watson. Specifically, the Examiner has relied Col. 16, line 63 -- Col. 17, line 8 from the Watson reference (reproduced above) to make a prior art showing of applicant's claimed technique "wherein obtaining for the user the member identifier used by the user to identify the user to the second online service comprises obtaining the member identifier from an operator of the second online service" (as currently amended).

Applicant again respectfully asserts that the excerpt from Watson relied upon by the Examiner merely discloses an "HH-PSX#," which is "the unique identifying number for households HH(l) keying to all other personal service exchange (PSX) databases and data views" (emphasis added). Further, Watson discloses that "[t]he data record also contains the unique personal service exchange (PSX) identifying number for the current transmitting service establishment SE(j)" (emphasis added).

However, the mere disclosure of a unique identifying number for household keying to all other personal service exchange databases, or that a data record contains the unique personal service exchange identifying number, as in Watson, fails to suggest a technique "wherein obtaining for the user the member identifier used by the user to identify the user to the second online service comprises obtaining the member identifier from an operator of the second online service" (emphasis added), as claimed by applicant. Clearly, a unique identifier keying to all other personal service exchange databases, as in Watson, simply fails to even suggest "obtaining the member identifier

from an operator of the second online service" (emphasis added), in the manner as claimed by applicant.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 56-57 below, which are added for full consideration:

"wherein the user is authenticated to the first online service utilizing the member identifier, the unique identifier, and a password of the user" (see Claim 56); and

"wherein the unique identifier includes an electronic mail address" (see Claim 57).

It should be noted that Claim 58-64 have been added, which include limitations similar to those set forth hereinabove. To this end, such claims are deemed allowable for similar reasons.

Yet again, a notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. AMDCP061).

Respectfully submitted,
Zilka-Kotab, PC.

/KEVINZILKA/

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100